



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,307	03/21/2001	Naoto Oku	50026/024001	2668

21559 7590 02/24/2004

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

EPPS FORD, JANET L

ART UNIT	PAPER NUMBER
----------	--------------

1635

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,307

Applicant(s)

OKU ET AL.

Examiner

Janet L. Epps-Ford

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-24-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-63 is/are allowed.
- 6) ☒ Claim(s) 26-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 28-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 28-46 are dependent from claim 26. Claim 26 recites wherein the base skeleton of the claimed compounds comprise seven or more nitrogen atoms wherein the degree of akylation is $\leq 24.5\%$. However, Claim 28, and those claims dependent therefrom recite formula (I) having a base skeleton of only 3 nitrogens. There is no antecedent basis in claim 26 to support wherein the base skeleton has less than seven nitrogen atoms.

Response to Amendment

3. The Declaration under 37 CFR 1.132 filed 11-24-03 is sufficient to overcome the rejection of claims 51-52, and 57-63 based upon 35 USC 112, second paragraph.

Response to Arguments

4. Claims 26-50 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the Office Action mailed 5-28-03.

Art Unit: 1635

5. Applicant's arguments filed 11-24-03 have been fully considered but are not persuasive. Applicants traverse the instant rejection on the grounds that the claims as amended have overcome this rejection. More specifically, Applicants have amended claim 26 to recite "seven or more nitrogen atoms, and wherein the degree of alkylation on said nitrogen atoms is \leq 24.5%." However, it is noted that there is no disclosed polyalkylenimine or salt thereof of seven nitrogen atoms comprising a degree of alkylation on said nitrogen atoms of 24.5% or less. Applicants referred to page 22, line 2 as support for the limitation "seven or more nitrogen atoms, and wherein the degree of alkylation on said nitrogen atoms is \leq 24.5%," however, page 22, line 2 describes P6C24.5, compound no. 6, a compound of 12 nitrogen atoms. Compound 6 as set forth in Figure 7, and described on page 22, does not provide support for a polyalkylenimine comprising a base skeleton of seven nitrogen atoms, wherein the degree of alkylation on said nitrogen atoms is 24.5% or less. It is also noted that all of the polyethylenimine compounds described on pages 20-22 and Figure 7, all have a molecular weight of app. 600. According to Applicants a molecular weight of 300 Da corresponds to a polyethylenimine of seven nitrogen atoms, however the compounds described on pages 20-22 and Figure 7 all have a molecular weight of app. 600 Da, suggesting polyethylenimine compounds of 14 nitrogen atoms.

Applicant's amendment to claim 26 constitutes new matter, since the specification as fails to provide proper antecedent basis for the claimed subject matter, particularly wherein the polyalkylenimines of claim 26 comprise "seven or more nitrogen atoms, wherein the degree of alkylation on said nitrogen atoms is \leq 24.5%. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 1635

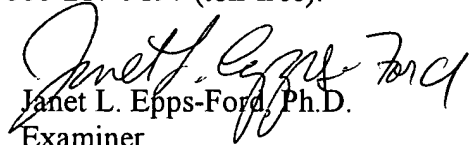
Conclusion

6. Claims 51-63 are free of the prior art or any combination thereof, and are allowable.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford, Ph.D. whose telephone number is 571-272-0757. The examiner can normally be reached on Monday-Saturday, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Janet L. Epps-Ford, Ph.D.
Examiner
Art Unit 1635

JLE